Remarks

Claims 1-21 are pending in the application. No amendments are made herein, no new matter has been added, and no new material presented that would necessitate an additional search on the part of the Examiner.

Applicant notes with appreciation that previous rejection of claims 1-21 under 35 U.S.C. §102(b) in view of Yagami et al. (U.S. patent number 5,738,100) has been withdrawn.

Claims are novel

The Office Action on page 2 rejects claims 1-21 under 35 U.S.C. §102(e) in view of Keast et al. (U.S. patent number 6,749,606, filed September 4, 2001).

According to criteria established in the Manual of Patent Examining Procedure, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Manual of Patent Examining Procedure* § 2131 (8th ed., Rev. 4, Oct. 2005), *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Thus, the standard for rejection under 35 U.S.C. §102 is identity.

Applicant below characterizes the subject matter in Keast et al. and shows that this reference is not the same as claims 1-21.

Keast et al., U.S. patent number 6,749,606, filed September 4, 2001

Keast shows devices and methods for altering gaseous flow in a diseased lung. See Keast, column 4, lines 10-11. The devices alter gaseous air flow within a lung to improve the expiration cycle of an individual having chronic obstructive pulmonary disease (COPD). Ibid., Abstract. Keast shows selecting a site for collateral ventilation of the diseased lung

and creating at least one collateral channel at the site. Ibid., column 4, lines 14-16. The term "channel" is defined as including an opening, cut, slit, tear, puncture, or any other artificially created opening. Ibid., column 4, lines 17-19. Keast further shows selecting a site for creating a collateral channel by visually examining areas of collateral ventilation, such as visually examining the lung using a fiber optic line or non-invasive imaging. Ibid., column 4, lines 26-32. The devices produce collateral openings or channels through the airway wall so that oxygen depleted/carbon dioxide rich air can pass out of the lung tissue. Ibid., Abstract.

The present claims are not the same as the cited art

The legal standard for rejection of a claim under 35 U.S.C. §102 is identity.

Keast fails to show an endoscopic imaging apparatus that includes at least one ultrasound transducer contained within the distal end of the endoscope, to which Applicant's claim 1 is directed.

The Office Action cites column 15, line 56 to column 16, line 61 of Keast, alleging that "Keast et al. disclose an endoscopic imaging apparatus comprising: an endoscope including a distal end; at least one ultrasound transducer contained within said distal end; and an outer protective shell directly covering said distal end and fabricated from an electrically insulating material having a Thermal Conductance greater than 1 W/M-°K overlaying at least a portion of said distal end."

A portion of the cited passage from Keast states:

> FIG. 5A illustrates a variation of a device **600** adapted to determine the presence of blood vessels as previously mentioned. The device **600** includes a flexible elongate member **604** having a transducer assembly **606**, at least a portion of which is located adjacent to a distal end of the elongate member **604**. Although the elongate member **604** is illustrated as having a lumen, the elongate member **604** may also be selected to be solid, or the elongate

> member **604** may have a support member (not shown) such as a braid to increase the strength and/or maneuverability of the device. The transducer assembly **606** is adapted to generate a source signal and receive a reflected signal. It may use a single transducer or multiple transducers. For example, at least a first transducer may be used to generate a signal and at least a second transducer may be used to receive the signal. [Keast, column 15, lines 56 to column 16, line 4; emphases added]

While this passage shows an elongate member with a transducer assembly adjacent to the distal end of the elongate member, the passage cited in the Office Action does not show an endoscopic imaging apparatus with at least one ultrasound transducer contained within the distal end of the endoscope, to which Applicant's claim 1 is directed. The cited passage also fails to show an outer protective shell directly covering the distal end that is fabricated from an electrically insulating material having a Thermal Conductance greater than 1 W/M-°K overlaying at least a portion of said distal end, to which Applicant's claim 1 is directed.

Further, Keast fails to show an endoscopic imaging apparatus with an outer protective shell directly covering the distal end and fabricated from an electrically insulating material having a Thermal Conductance greater than 1 W/M-°K overlaying at least a portion of the distal end, to which Applicant's claim 1 is directed.

Further, Keast fails to show an apparatus for dissipating thermal energy produced by an endoscopic imaging apparatus that is configured and dimensioned to mate with a distal end of the imaging apparatus for dissipating thermal energy produced at the distal end. Keast also fails to show an apparatus fabricated from an electrically insulating material having a Thermal Conductance greater than 1 W/M-°K and comprising an outer protective shell directly covering the distal end, to which Applicant's claim 9 is directed.

Keast also fails to show any method for scanning a patient's heart using a TEE probe, to which Applicant's claim 15 is directed.

Further, Keast fails to show any device for passively dissipating thermal energy produced by at least one transducer located at a distal end of an endoscopic imaging apparatus, where the device comprises an outer protective shell directly covering the distal end and is configured and dimensioned to encase the at least one transducer, to which Applicant's claim 21 is directed.

As Keast is not the same as the subject matter of claims 1, 9, 15 and 21, these claims are not anticipated by Keast. Claims 2-8, 10-14 and 16-20 depend directly or indirectly on claims 1, 9, and 15, respectively, and incorporate the subject matter of these claims and contain additional subject matter. As claims 1, 9, 15 and 21 are not anticipated by Keast, therefore claims 2-8, 10-14 and 16-20 also are not anticipated by this reference.

Applicant asserts that claims 1-21 are novel with respect to Keast, and respectfully requests that rejection under 35 U.S.C. §102(e) be withdrawn.

Summary

On the basis of the foregoing reasons, Applicant respectfully submits that the pending claims are in condition for allowance, which is respectfully requested.

If there are any questions regarding these remarks, the Examiners are invited and encouraged to contact Applicant's representative at the telephone number provided.

Respectfully submitted,

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